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| 09/017,329 | 02/02/1998 | RYUICHI MATSUKURA | 1083.1049/JD | 8159 |

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| EXAMINER |
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CARDONE, JASON D

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| ART UNIT | PAPER NUMBER |
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2145

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/017,329

Applicant(s)

MATSUKURA, RYUICHI

Examiner

Jason D. Cardone

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 16-22 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 16-22 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the RCE of the applicant, filed on 3/21/05. Claims 1-11, 16-22 and 26 are presented for further examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-11, 16-22 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1-10, 16, 17, 20 and 21 disclose "a position in the real world" for each hardware or software. The specification does not teach a position in the real world for each item. Claim 22 discloses a user controls the resource setting but this is not disclosed in the specification for one of ordinary skilled in the art to understand. Claim 26 discloses resource setting means "directly receives" content but this is not taught in the specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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5. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-11 recite the limitation "the content". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-11, 16-22 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Savitzky et al. ("Savitzky"), USPN 6,012,083.

Regarding claim 1, Savitzky discloses a computer network system in which plural connecting means capable of connecting and disconnecting a computer is provided in a network circuit to which a first computer has been connected [ie. PDA, Savitzky, col. 20, lines 40-67], and a second computer is connected to one of the connecting means, wherein the first computer comprises resource information managing means for managing information relating to hardware or software, including a position in the real world for each of the hardware or software, which are usable through the network circuit, and resource information processing means for taking out the content of the

resource information managing means in response to a request of information relating to usable hardware or software from another computer, and transmitting to the network circuit [ie. printer agency (first computer) with printer (resource) information to send to client (PDA), Savitzky, col. 13, lines 15-63],

the second computer comprises resource setting means for setting the hardware or software according to the content of the hardware or software information transmitted by the resource information processing means of the first computer, and when the second computer is connected to the network circuit through any one of the plural connecting means, the resource setting means receives the content of the hardware or software information transmitted by the resource information processing means of the first computer and sets the hardware or software [ie. PDA sets the printer, Savitzky, col. 13, lines 15-28 and col. 20, lines 40-67].

8. Regarding claim 26, Savitzky further discloses the resource setting means directly receives the content of the hardware or software information transmitted by the resource information processing means [Savitzky, col. 13, lines 15-28].

9. Regarding claims 2-11 and 16-22, claims 2-11 and 16-22 have similar limitations as claims 1 and 26. Therefore, they are rejected under Savitzky for the same reasons set forth in the rejection of claims 1 and 26 [Supra 1 and 26].

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-11, 16-22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yacoub, USPN 6,552,813, in view of Carpenter et al. ("Carpenter"), USPN 6,477,581.

12. Regarding claim 1, Yacoub discloses a computer network system in which plural connecting means is provided in a network circuit to which a first computer has been connected, and a second computer is connected to one of the connecting means, wherein; the first computer comprises resource information managing means for managing information relating to hardware or software, including a position in the real world for each of the hardware or software, which are usable through the network circuit, and resource information processing means for taking out the content of the resource information managing means in response to a request of information relating to usable hardware or software from another computer, and transmitting to the network circuit [ie. the server, Yacoub, col. 5, line 35 – col. 7, line 9 and col. 10, lines 28-65];

the second computer comprises resource setting means for setting the hardware or software according to the content of the hardware or software information transmitted by the resource information processing means of the first computer [ie. the client with virtual printer, Yacoub, col. 4, line 28 – col. 5, line 13 and col. 11, lines 1-60]; and

when the second computer is connected to the network circuit through any one of the plural connecting means, the resource setting means receives the content of the hardware or software information transmitted by the resource information processing means of the first computer and sets the hardware or software [Yacoub, col. 4, line 28 – col. 5, line 13 and col. 6, lines 46-65].

Yacoub does disclose the use of portable data assistant (PDA) does not specifically disclose connecting means capable of connecting and disconnecting a computer. However, Carpenter, in the same field of endeavor, discloses connecting means capable of connecting and disconnecting a computer [Carpenter, col. 3, line 48 – col. 4, line 40 and col. 5, lines 12-44]. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate connections means for portable devices, disclosed by Carpenter, in the network system, disclosed by Yacoub, in order to have user-friendly connection [Carpenter, col. 1, line 62 – col. 2, line 9].

13. Regarding claim 2, claim 2 has similar limitations as claim 1 and additional limitations of a resource installation position managing means for managing the position at which the resource managed by the resource information managing means exists and selecting an arbitrary resource. Therefore, the similar limitations are disclosed under Yacoub-Carpenter for the same reasons set forth in the rejection of claim 1 [Supra 1]. Also, Yacoub-Carpenter further discloses the resource installation position managing means for managing the position at which the resource managed by the

resource information managing means exists and selecting an arbitrary resource [Yacoub, col. 10, lines 28-65].

14. Regarding claim 3, claim 3 has similar limitations as claim 1 and additional limitations of a resource information holding means for holding the resource information relating to the resources that can be managed directly and comparing means for comparing the content of the resource information holding means and the content of the resource information managing means of the first computer, detecting a replaceable resource. Therefore, the similar limitations are disclosed under Yacoub-Carpenter for the same reasons set forth in the rejection of claim 1 [Supra 1]. Also, Yacoub-Carpenter further discloses resource information holding means for holding the resource information relating to the resources that can be managed directly and comparing means for comparing the content of the resource information holding means and the content of the resource information managing means of the first computer, detecting a replaceable resource [Yacoub, col. 6, line 46 – col. 7, line 9].

15. Regarding claim 5, claim 5 has similar limitations as claim 1 and additional limitations of a resource information holding means for holding the resource information relating to the resources that can be managed directly and comparing means for comparing the content of the resource information holding means and the content of the resource information managing means of the first computer, detecting a replaceable resource. Therefore, the similar limitations are disclosed under Yacoub-Carpenter for

the same reasons set forth in the rejection of claim 1 [Supra 1]. Also, Yacoub-Carpenter further discloses resource information holding means for holding the resource information relating to the resources that can be managed directly and comparing means for comparing the content of the resource information holding means and the content of the resource information managing means of the first computer, detecting a replaceable resource [Yacoub, col. 6, line 46 – col. 7, line 9].

16. Regarding claim 6, claim 6 has similar limitations as claim 1 and additional limitations of a resource updating means for updating the content of the resource information managing means when receiving an updated resource. Therefore, the similar limitations are disclosed under Yacoub-Carpenter for the same reasons set forth in the rejection of claim 1 [Supra 1]. Also, Yacoub-Carpenter further discloses a resource updating means for updating the content of the resource information managing means when receiving updated resource information [Yacoub, col. 2, lines 25-29 and col. 6, lines 32-42].

17. Regarding claims 10-11, claims 10-11 has similar limitations as claim 1 and additional limitations of a resource noticing means for noticing the content of the resource information managing means and updating resource information registering means by receiving the updated resource information from the computer. Therefore, the similar limitations are disclosed under Yacoub-Carpenter for the same reasons set forth in the rejection of claim 1 [Supra 1]. Also, Yacoub-Carpenter further discloses a

resource noticing means for noticing the content of the resource information managing means and updating resource information registering means by receiving the updated resource information from the computer [Yacoub, col. 6, lines 32-42].

18. Regarding claim 26, Yacoub-Carpenter further discloses the resource setting means directly receives the content of the hardware or software information transmitted by the resource information processing means [ie. receiving information directly to the virtual printer on the client, Yacoub, col. 11, lines 40-60].

19. Regarding claims 4, 7-9 and 16-22, claims 4, 7-9 and 16-22 have similar limitations as claim 1. Therefore, they are rejected under Yacoub-Carpenter for the same reasons set forth in the rejection of claim 1 [Supra 1].

Response to Arguments

20. Applicant's arguments filed 12/20/04 have been fully considered but they are not persuasive.

21. (A) Yacoub does not disclose the resource setting means directly receives the content of the hardware or software information

As to point (A), Yacoub does disclose the resource setting means directly receives the content of the hardware or software information. Yacoub discloses a virtual printer, on the client, that receives content about printers from the server. This

information is used to select a printer [Yacoub, col. 11, lines 40-60]. During patent examination and prosecution, claims must be given their broadest reasonable interpretation. *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993); *In re Prater*, 415 .2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). Giving the instant claims their broadest reasonable interpretation, “directly receiving” is broad enough to read on the virtual printer as disclosed in Yacoub.

22. (B) Yacoub does not disclose a user controls the resource-setting unit.

As to point (B), Yacoub does disclose a user controls the resource-setting unit by sending the preferences of the user to the virtual printer to select the appropriate printer [Yacoub, col. 11, lines 40-60]. During patent examination and prosecution, claims must be given their broadest reasonable interpretation. *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993); *In re Prater*, 415 .2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969).

23. (C) Can not combine Yacoub and Carpenter.

As to point (C), Carpenter does disclose connecting means capable of connecting and disconnecting a computer [Carpenter, col. 3, line 48 – col. 4, line 40 and col. 5, lines 12-44]. Carpenter discloses the use of PDAs, also shown by Yacoub [Yacoub, col. 11, lines 1-19], that connect to servers [Carpenter, col. 4, line 1-64]. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate show detail of connections means for portable devices, disclosed

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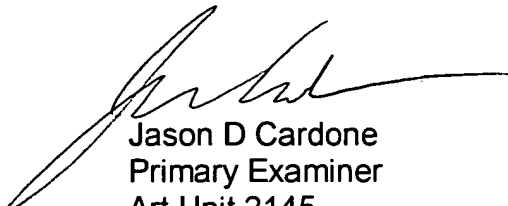
by Carpenter, in the network system, disclosed by Yacoub, in order to have user-friendly connection [Carpenter, col. 1, line 62 – col. 2, line 9]. Carpenter discloses setting up connections [Carpenter, col. 2, lines 1-9]. It is noted that the features upon which applicant relies (i.e., establishing a new connection) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone whose telephone number is (571) 272-3933. The examiner can normally be reached on Mon.-Thu. (6AM-3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone
Primary Examiner
Art Unit 2145

May 30, 2005